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| 10/597,458   | 02/26/2007  | Torben Liltorp Moeller | 042933/314546                   | 1362                   |
| 836  | 7590        | 07/29/2009             |                                 |                        |
| ALSTON & BIRD LLP<br>BANK OF AMERICA PLAZA<br>101 SOUTH TRYON STREET, SUITE 4000<br>CHARLOTTE, NC 28280-4000 |             |                        | EXAMINER<br>GEORGEWILL, OPIRIBO |                        |
|  |             |                        | ART UNIT<br>2617                | PAPER NUMBER           |
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/597,458

**Applicant(s)**

MOELLER, TORBEN LILTORP

**Examiner**

OPIRIBO GEORGEWILL

**Art Unit**

2617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 July 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SF/ICE)
- Paper No(s)/Mail Date 6/25/2008 and 7/26/2006
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following minor informalities:

Paragraph [57] line 6 in the specification of the disclosure recites "The loop 72 and the loop 74" referring to fig 2. However, there is no loop 74 in figure 2; rather there is a loop 76. The reference number should be changed from 74 to 76.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1-19 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 1, the language "such as" renders the claim indefinite, since it not clear whether that which follows (SAM messages) is positively claimed or not.

Claims 2, 3, 4, 5, 6 and 7 are rejected for being dependent upon the rejected base claims 1.

Re claim 10, the language "such as" renders the claim indefinite, since it not clear whether that which follows (SAM messages) is positively claimed or not.

Claims 11, 12, 13, and 15 are rejected for being dependent upon the rejected base claims 10.

Re claim 18, the language "such as" renders the claim indefinite, since it not clear whether that which follows (SAM messages) is positively claimed or not.

4. Claim 3 recites the limitation "said predetermined length" in the first line. There is insufficient antecedent basis for this limitation in the claim.

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in Graham v. John Deere Co., 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows: *(See MPEP Ch. 2141)*

- a. Determining the scope and contents of the prior art;
  - b. Ascertaining the differences between the prior art and the claims in issue;
  - c. Resolving the level of ordinary skill in the pertinent art; and
  - d. Evaluating evidence of secondary considerations for indicating obviousness or nonobviousness.
6. Claims 1 - 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dolan, Michael Francis., European Patent Pub. No. 0981252 A2 in view of Akahane, Masaaki., US Pat No. 6226533 B1 and further in view of Watkins, Andrew., US Pub. No. 20050180392 A1.

Re claim 1, Dolan discloses a terminal (fig 3, ref 120) for concatenating recorded audio data packages each having a predefined length (see paragraph

[8], Short Audio Message), such as SAM messages, into an audio message of variable length (paragraph [27]), each of said recorded audio data packages forwarded from said terminal to a receiving terminal through an interconnecting telecommunication network (paragraph [24] , SMS message sent across one or more intervening networks between a message center and the end user's equipment), and said terminal comprising:

(b) a recorder for recording each of said audio data packages (fig 3, ref 304, paragraphs [21], [44]),

(c) a concatenation unit for concatenating said recorded audio data packages into said audio message (fig 3, ref 315, paragraph [45]), and

(d) a transmitter for transmitting each of said recorded concatenated audio data packages through said telecommunication network to said receiving terminal (fig 1, paragraphs [29] - [30]).

Dolan discloses the claimed invention but is silent on the user interface. Akahane in analogous art discloses a system for where voice messages are transmitted and received that includes a message indicator so as to stimulate message brevity in a user (see Akahane, abstract; paragraph 1, lines 6 – 11; paragraph 3, lines 32 – 36). Akahane further discloses user interface to display a duration indicator or remaining message memory capacity indicator (counter for counting the length of an audio message) (col 4, line 48 - col 5, line 9; fig 1, ref 60). The counting of recorded length and the remaining length are with the same skill sets of a person having ordinary skills and the choice of which to display is design

choice. It would therefore have been obvious to a person having ordinary skills, at the time of the invention, to incorporate the teaching of Akahane into the disclosure of Dolan to display a counter counting recorded length of audio data being recorded in an audio data package so as to stimulate message brevity to a user.

Dolan in view of Akahane is discloses the claimed invention but is silent a second counter counting the number of audio data packages. Watkins in analogous art discloses a system that preparing and storing message to be transmitted over a network (see abstract) so as to reduce message size (paragraph [6]). Watkins further discloses that a device may indicate on the display out device how many portions are presently contained in the message. It would therefore have been obvious to a person having ordinary skills, at the time of the invention, to incorporate the teaching of Watkins into the disclosure of Dolan in view of Akahane, as a whole, to have a second counter counting the number of recorded audio data packages so as to reduce message size.

The rejection of claim 1 is incorporated herein. Claims 2, 3, 4, 5, 6 and 7 depend on claim 1 and only further limitations will be addressed below.

Re claim 2, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that recorder comprises a microphone (Dolan: paragraph [17], the mobile user may also utilize this invention to be the initiator of a short audio message; also paragraph [1] discloses the mobile to be a

mobile telephone; it would be obvious to a person having ordinary skills in the art that a telephone would have a microphone)

Re claim 3, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses a predetermined length (Dolan: paragraph [33], discloses a message limit of 10 seconds).

Re claim 4, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses the terminal is a mobile telephone (Dolan: paragraph [1]).

Re claim 5, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that the receiving terminal is a mobile telephone (Dolan: paragraph [1]).

Re claim 6, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses wherein said receiving terminal comprises a computer terminal (Dolan: paragraph [13], personal computer), in a computer network (Dolan: paragraph [13], intervening network could be the internet), said computer terminal being adapted to connect to said telecommunication network through a gateway interconnecting said telecommunication network and said computer network (paragraph [27], intervening networks between message center and end user's equipment. A person having ordinary skills in the art, at the time of the invention would recognize this when the terminal is a wireless phone connected via one of the wireless radio links (see paragraph [30]) and the receiving device is a computer connected to the internet)

Re claim 7, the combined teaching of Dolan in view of Akahane and further in view of Watkins discloses that the telecommunication network is wireless (paragraph [30]).

The rejection of claim 7 is incorporated herein. Claim 8 and 9 depend on claim 7 and only further limitations will be addressed below.

Re claim 8, the combined teaching of Dolan in view of Akahane and further in view of Watkins is silent on the telecommunication network using general packet radio service transmission format. However the combined prior arts disclose using GSM standard (paragraph [32]) which at the time of the invention GSM users could use GPRS. It would therefore be obvious to a person having ordinary skill in the art, at the time of the invention, to use GPRS transmission format because it would have been obvious to try.

Re claim 9, the combined teaching of Dolan in view of Akahane and further in view of Watkins is silent on the telecommunication network using universal telecommunication services transmission service. However the combined prior arts disclose a GSM standard (paragraphs [31] - [32]) which at the time of the invention UMTS used GSM's Mobile Application Part and the GSM family of speech codecs). It would therefore be obvious to a person having ordinary skill in the art, at the time of the invention, to use UMTS transmission format because it would have been obvious to try.

Re claim 10, the first limitation is rejected for the same reasons as claim one. Furthermore, the receiving and outputting of the audio and



telecommunication network for interconnecting the transmitter and receiver are expected in the terminal disclosed in the rejection of claim one (see Dolan paragraph [17], where Dolan discloses that the same mobile unit can be initiator or receiving unit.; paragraph [19], the audio message is subsequently played back (loud speaker) to the recipient).

The rejection of claim 10 is incorporated herein. Claims 11, 12, 13, 15 depend on claim 10 and only further limitations will be addressed below.

Re claim **11**, it contains similar limitations to claim 2 and is rejected for the same reasons as above.

Re claim **12**, it contains similar limitations to claim 5 and is rejected for the same reasons as above.

Re claim **13**, it contains similar limitations to claim 6 and is rejected for the same reasons as above

Re claim **15**, it contains similar limitations to claim 7 and is rejected for the same reasons as above.

The rejection of claim 13 is incorporated herein, claim 14 depends on claim 13 and only further limitations will be addressed below.

Re claim **14**, it contains similar limitations to claim 6 and is rejected for the same reasons as above.

The rejection of claim 15 is incorporated herein. Claims 16 and 17 depend on claim 15 and only further limitations will be addressed below.

Re claim **16**, it contains similar limitations to claim 8 and is rejected for the same reasons as above

Re claim **17**, it contains similar limitations to claim 9 and is rejected for the same reasons as above.

Re claim **18**, it contains similar limitations to claim 1 and is rejected for the same reasons as above

Re claim **19**, it contains similar limitations to claim 1 and is rejected for the same reasons as above.

#### ***Contact Information***

- Any inquiry concerning this communication or earlier communications from the examiner should be directed to OPIRIBO GEORGEWILL whose telephone number is (571)270-7926. The examiner can normally be reached on Monday through Thursday, 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lester Kincaid can be reached on (571)272-7922. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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